

R E M A R K S

Claims 4, 6-9, 12-17, 19-21, 23, and 25-33 are pending. No new matter has been added by way of the present amendments. For instance, claim 21 has been amended to define X^2 as a heterocyclic group, an unsubstituted amino group, an aryl group or an alkyl group" as supported by the present specification at page 43. Concerning the "alkyl" group, the Examiner's attention is particularly drawn to the examples of X listed at pages 35-37 of the present specification. Note that X^2 is defined, at page 43, line 15 as a hydrogen atom or a substituent, which substituent can be derived from examples of X listed at pages 35-37 by selecting groups corresponding to $-OC(=O)-X^2$. The examples of X include an acyloxy group (see page 35, lines 19-20). The term "acyl" of the "acyloxy" group may be generally represented by $RCO-$ (see attached McGraw-Hill Dictionary of Scientific and Technical Terms), wherein R is aliphatic, alicyclic or aromatic. Additionally, as an example of an aliphatic group, "alkyl group" is described at page 26 of the present specification. Similar support exists for newly added claim 33. Claim 23 has been amended by incorporating the subject matter of previously pending claim 30, as supported by the present specification at page 119, lines 8-25. The phrase "after it is dispersed" has been added to claims 25, 26 and 28, as supported by the present specification at page 119, lines 8-25.

Also, claim 30 has been amended to depend upon claim 21 and to define the temperature as 60°C or more, as supported by the present specification at page 119, lines 8-25. Lastly, claims 11, 22 and 24 have been cancelled. Accordingly, no new matter has been added.

In view of the following remarks Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. §103(a)

The Examiner has rejected claims 4, 6-8, 12-17, 19-24, 29, and 30 have been rejected under 35 U.S.C. 103(a) as being obvious over Fujita et al. (5,273,866) in view of Sakai (5,573,898) and Mifune et al. (4,713,321).

The Examiner has also rejected claims 12-17, 19, 20, 23, 24, and 30 have been rejected under 35 U.S.C. 103(a) as being obvious over Fujita et al. in view of Ohshima et al. (5,391,471) and Mifune et al.

Claims 9 and 11 have been rejected under 35 U.S.C. 103(a) as being obvious over Fujita et al. in view of Sakai et al. and Mifune et al. (or alternatively Oshima et al. in view of Sakai and Mifune et al.), in view of Swank et al. (4,006,025).

Claims 25-28 have been rejected under 35 U.S.C. 103(a) as being obvious over Fujita et al. in view of Sakai et al. and

Mifune et al. in further view of Onishi et al. (4,474,872).

Lastly, claims 31 and 32 have been rejected under 35 U.S.C. 103(a) as being obvious over Fujita et al. in view of Sakai et al. and Mifune et al. or alternatively over Fujita et al. in view of Sakai et al. and Mifune et al. in further view of Research Disclosure 17643.

Applicants respectfully traverse each of the above rejections.

There are four independent claims which are currently pending in the present application, claims 21, 23, 25 and 26. Applicants will address each of these claims individually below and explain why these claims, as well as the claims which depend thereon, are distinguished from the cited art.

Claim 21

Claim 21 is the subject of a rejection based upon Fujita et al. (5,273,866) in view of Sakai (5,573,898) and Mifune et al. (4,713,321). However, Applicants respectfully submit that even if the Fujita, Sakai and Mifune references are taken as a whole, one of skill in the art cannot arrive at the subject matter of claim 21.

Additionally, Applicants have already submitted the results of a comparative experiment with respect to coupler C-41 set forth in the Sakai patent, which is the most closely related

preceding technique and also to phenol-based couplers. However, the Examiner has asserted that the comparative results with respect to the cyan dye-forming coupler (Formula C-2) are not commensurate in scope with the present claims. Applicants respectfully disagree with the Examiner in this regard. Even though coupler 41 of Sakai may fall within the preferred embodiment of the present invention, it is still the closest prior art compound. The comparative showing need not compare the claimed invention with all of the cited prior art, In re Fenn et al., 208 USPQ 470 (CCPA 1981), but only with the closest prior art. In re Holladay, 199 USPQ 516 (CCPA 1978); see also In re Merchant, 197 USPQ 785 (CCPA 1978); see also In re Wood et al., 202 USPQ 171 (CCPA 1979). In the case of chemical compounds, this means only the compound or compounds closest structurally thereto must be tested.

However, in order to further prosecution, Applicants have amended claim 21 to define the substituent X². Applicants have also prepared an additional comparative experiment set forth in the attached Declaration pursuant to 37 CFR § 1.132. This Declarative evidence is being submitted as a response to the Examiner's request for more experimentation. The new evidence addresses the scope of X² in amended claim 21 of the present application.

A review of the evidence of record, as well as the newly submitted evidence reveals that due to the combination of the individual constituent features in claim 21 of the present application, superior results are achieved. These results are unexpected in view of the cited art of Fujita. Further, even if the Sakai patent and the Mifune patent were combined together, Applicants submit that the results achieved are far superior to the results that may hypothetically be expected.

In summary, Applicants submit that the submitted evidence is fully commensurate in scope with the present claims. Moreover, based upon the unexpected results obtained by the present invention, the Examiner's rejection of claim 21 under 35 USC § 103(a) is overcome. Reconsideration and withdrawal thereof are requested.

Claim 23

Claim 23 is the subject of a rejection under 35 U.S.C. 103(a) as being obvious over Fujita et al. (5,273,866) in view of Sakai (5,573,898) and Mifune et al. (4,713,321). Claim 23 is further the subject of a rejection under 35 U.S.C. 103(a) as being obvious over Fujita et al. in view of Ohshima et al. (5,391,471) and Mifune et al. Applicants respectfully traverse these rejections.

Applicants submit that the subject matter and results associated with claim 23 cannot be achieved or expected through

the combination of the Sakai and Mifune patents with the Fujita patent, or through the combination of the Ohshima and Mifune patents with the Fujita patent.

First, Applicants submit that the compounds represented by formula [XI] of the present application are water-soluble dyes, which are not to be incorporated into a photosensitive material as a solid fine particle dispersion as stated in claim 23, wherein the method of incorporation is defined. Rather, since the dye is soluble in water, it is impossible to provide a solid fine particle dispersion. In contrast, III-27 and III-32 of Fujita are completely different from the dyes represented by formula [XI] of the present application, since the two dyes can be dispersed as solid fine particles. Also, the heterocyclic structure itself of III-34 in Fujita is not within the scope of formula [XI] of the present application.

Second, the light-sensitive material film pH defined in claim 23 of the present application does not correlate with the emulsion pH as set forth in Fujita. In addition, Fujita fails to suggest or disclose that the dye to be compared with the compound represented by formula [XI] of the present application is incorporated into a light-sensitive material by a method other than that for the solid fine particle dispersion as set forth in claim 23 of the present application.

Third, the simple description of the film pH for the case of color paper in the Ohshima patent cannot necessarily be directly applicable to a color photographic light-sensitive material for movie, a special dedicated product.

Each of the above arguments is sufficient to rebut the Examiner's rejection. However, to further prosecution, Applicants have amended claim 23 such that it relates to a dispersion, which comprises solid fine particles of a dye represented by formula [I] and has been subjected to heat treatment at 40°C or higher after dispersion. Such a dispersion, having post-preparation heat treatment, is neither suggested nor described in any of the Fujita, Sakai, Mifune, Ohshima and Onishi (4,474,872) patents.

Further to this, Applicants point out that though specific temperatures, i.e., 60°C to 80°C, are explicitly set forth in the Onishi patent, these temperatures apply to the preparation temperatures of the dispersion, and not temperatures for heat treatment after the dispersion has been prepared. Moreover, the Onishi patent neither suggests nor discloses heat treatment of the dispersion after its preparation.

Further, Applicants point out that in the Swank patent (4,006,035), similarly to the Onishi patent, heating to 40°C to 50°C does not mean heat treatment for the dispersion after its preparation, but rather the heating temperatures during

dispersion. Thus, these temperatures are different from present claim 23. Further, Swank fails to suggest or disclose heat treatment of a dispersion after its preparation.

In summary, Applicants submit that the Examiner has failed to present a valid *prima facie* case of obviousness. Accordingly, the Examiner's rejections based upon claim 23 and the claims, which depend thereon, are improper. Reconsideration and withdrawal thereof are requested.

Claim 25

Claim 25 is the subject of a rejection under 35 U.S.C. 103(a) as being obvious over Fujita in view of Sakai and Mifune and Onishi (4,474,872). Applicants respectfully traverse this rejection.

Although the Onishi patent sets forth the temperatures of 60°C to 80°C, these temperatures represent conditions for its preparation, rather than temperatures of treatment of the dispersion after preparation (after dispersing). Onishi fails to suggest or disclose heat treatment of the dispersion at a particular temperature after the dispersing operation, i.e., after the dispersion has been prepared. In fact, Onishi fails to suggest heat treatment of the dispersion after preparation at all. In contrast, claim 25 requires that the solid fine

particle dispersion of the dye of formula [I] is heat-treated at 60°C or more after it is dispersed.

Further, Applicant submit that one of ordinary skill in the art is provided with no motivation to select, among a variety of dispersing methods, the Onishi patent in order to combine with the technique of the present application.

Applicants further point out that although the Swank patent No. 4,006,025 discloses heating to 40°C to 50°C, similarly to the Onishi patent, this does not mean heat treatment for the dispersion after its preparation, but rather heating temperatures during dispersion. This is again distinct from claim 25. Also, Swank fails to suggest or disclose heat treatment of the dispersion after its preparation.

In summary, Applicants submit that the Examiner has failed to present a valid *prima facie* case of obviousness. Accordingly, the Examiner's rejections based upon claim 25 and the claims, which depend thereon, are improper. Reconsideration and withdrawal thereof are requested.

Claim 26

Similar to the rejection of claim 25, claim 26 is also the subject of a rejection under 35 U.S.C. 103(a) as being obvious over Fujita in view of Sakai and Mifune in further view of Onishi. For the same reasons discussed above concerning claim 25,

Applicants traverse the rejection of claim 26.

To summarize, claim 26 requires that the solid fine particle dispersion of the dye of formula [I] be heat-treated at 60°C or more after it is dispersed. The art cited by the Examiner fails to suggest or disclose such a post-dispersion heat treatment, let alone disclosing such treatment at 60°C or more.

Accordingly, Applicants submit that the Examiner has failed to present a valid *prima facie* case of obviousness. Accordingly, the Examiner's rejections based upon claim 26 and the claims, which depend thereon, are improper. Reconsideration and withdrawal thereof are requested.

In view of the above remarks, as well as the present claims and Declarative evidence or record, Applicants respectfully submit that the Examiner has failed to present a valid *prima facie* case of obviousness. The cited references, whether taken individually or as a whole, fail to suggest or disclose the presently claimed subject matter. Moreover, even if the Examiner has hypothetically presented a valid *prima facie* case of obviousness (for instance, concerning claim 21, a point not conceded by Applicants), the unexpected results of the present invention compared to the cited art rebut any hypothetical case of obviousness. Accordingly, the Examiner's rejections are moot. Reconsideration and withdrawal thereof are respectfully requested.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Pursuant to 37 C.F.R. 1.17 and 1.136(a), the Applicants respectfully petition for a three (3) month extension of time for filing a response in connection with the present application. The required extension fee of \$950.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: _____


Marc S. Weiner, # 32,181
Craig A. McRobbie, # 42,874

MSW/CAM:bmp

P. O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Excerpt from McGraw-Hill Dictionary of Scientific and Technical Terms;
Declaration under 37 C.F.R. 1.132